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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Serial No. : 09/674,443 Confirmation No. (None assigned)  
Appellant : Sherif Safwat  
Filed : October 27, 2000  
Title : BIOELECTRIC SIMULATING FISH-  
HOOK AND LURE AND METHOD OF  
USING SAME  
TC/A.U. : 3643  
Examiner : Kurt C. Rowan  
  
Docket No. : 2146  
Customer No.: 23320

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

Sir:

**APPEAL BRIEF TRANSMITTAL**

Enclosed herewith are three (3) copies of an Appeal Brief for  
this patent application together with a check in the amount of the  
small entity fee for filing a brief in support of an appeal.

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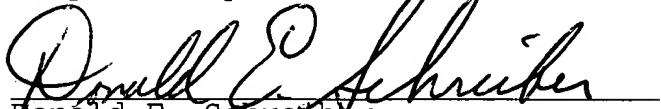
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If any additional fee is required, the Commissioner for Patents is hereby authorized to charge any deficiency or credit any surplus in any relevant fee to Deposit Account No. 19-0735. A duplicate copy of this transmittal letter is enclosed herewith.

Respectfully submitted



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

I hereby certify pursuant to 37 C.F.R. § 1.8(a)(1) that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

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Sir:

**APPEAL BRIEF**

Pursuant to 37 C.F.R. § 1.192, through his undersigned attorney the Appellant submits in triplicate the following brief appealing a rejection of claims that appears in an Office Action dated March 8, 2004.

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#### Real Party in Interest

The real party in interest is Appellant, Sherif Safwat.

#### Related Appeals and Interferences

Appellant is unaware of any presently pending appeal or interference that is related to this appeal.

#### Status of the Claims

Claims 1-47 are pending in this application, claims 1-47 have been finally rejected, and that rejection of claims is being appealed.

#### Status of Amendments

Appellant last amended the claims in a response received in the United States Patent and Trademark Office ("USPTO") on May 30, 2003, to an Office Action dated January 30, 2003, Paper no. \_\_. Pursuant to an Office Action dated March 8, 2004, Paper No. \_\_, claims 1-47 as amended in the May 30, 2003, response stand finally rejected.

#### Summary of the Invention

The invention, as presently expressed in the independent claims, is fishing gear which includes an electret for inducing a strike response in fish.

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The Issues

- I. Whether under 35 U.S.C. § 103(a) claims 1-3, 12-15, 24, 26 and 40-41 are unpatentably obvious over United States Patent no. 4,715,142 entitled "Self-Destruct Fish Hook" which issued December 29, 1987, on an application filed by Joseph D. Richard ("the Richard patent").
- II. Whether under 35 U.S.C. § 103(a) claims 4-11, 16, 25 and 42-47 are unpatentably obvious over the Richard patent as applied to claim 1, and further in view of United States Patent no. 4,893,430 entitled "Multi-Jointed Beaded Fishing Worm Lure" which issued January 16, 1990, on an application filed by Timmy R. Barfield ("the Barfield patent").
- III. Whether under 35 U.S.C. § 103(a) claims 22-24 and 37-39 are unpatentably obvious over United States Patent no. 4,970,808 entitled "Electro-Acoustical Fishing Lure" which issued November 20, 1990, on an application filed by Lewis E. Massie ("the Massie patent").
- IV. Whether under 35 U.S.C. § 103(a) claims 17-22 and 27-36 are unpatentably obvious over United States Patent no. 5,697,182 entitled "Fishing Lure" which issued December 16, 1997, on an application filed by Nicholas A. Rodgers ("the Rodgers patent").

Claim Groups

As specified below, claims 1-47 do not stand or fall together.

- I. Claims 1-3, 12-15, 24, 26 and 40-41 stand or fall together due to their rejection based upon the Richard patent.
- II. Claims 4-11, 16, 25 and 42-47 stand or fall together due to their rejection based upon the Richard patent as applied to claim 1, and further in view of the Barfield patent.
- III. Claims 22-24 and 37-39 stand or fall together due to their rejection based upon the Massie patent.<sup>1</sup>
- IV. Claims 17-22 and 27-36 stand or fall together due to their rejection based upon the Rodgers patent.<sup>2</sup>

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<sup>1</sup> Note that the final rejection of claims in the March 8, 2004, Office Action, due to its incorporation by references of rejections appearing in the July 1, 2003, Office Action, rejects claim 24 based upon both:

- 1. the Richard patent in paragraph no. 4 of the July 1, 2003, Office Action; and
- 2. the Massie patent in the first paragraph no. 6 that appears in the lower half of page 4 of the July 1, 2003, Office Action.

<sup>2</sup> Note that the final rejection of claims in the March 8, 2004, Office Action, due to its incorporation by references of rejections appearing in the July 1, 2003, Office Action, rejects claim 22 based upon both:

- 1. the Massie patent in the first paragraph no. 6 that appears in the lower half of page 4 of the July 1, 2003, Office Action; and
- 2. the Rodgers patent in the second paragraph no. 6 that begins at the top of page 5 of the July 1, 2003, Office Action.

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### Argument

#### The References

##### The Richard Patent

The Richard patent's Abstract describes a self-destructing, steel fish hook having:

1. a selected small anodic area of exposed steel; and
2. a highly cathodic plating covering a much larger area of the fish hook's surface.

Immersing the fish hook in water operates to create a galvanic couple between the fish hook's dissimilar metals that results in the small anodic area of exposed steel corroding rapidly thus causing the fish to eventually break.

The Richard patent discloses that an embedded fish hook in a free swimming fish can take many months to disintegrate, depending on its steel composition and the protective plating. Meanwhile, possible adverse effects of the embedded hook with its attached remnant of line or leader could include impairment of fish feeding behavior and/or ulceration or infection of the hook wound. The Richard patent states that it appears likely that these cumulative effects significantly reduce the chances of survival of released fish. The invention disclosed in the Richard patent enhances the survivability of released fish by greatly increasing the rate at which fish hooks used in the sport fisheries degrade upon immersion in seawater. (Col. 1, lines 36-44)

**The Barfield Patent**

The Barfield patent's Abstract describes a multi-jointed, artificial fishing worm (A) which includes a buoyant head (B) and a beaded worm body (C). The beaded worm body (C) has a major length and consisting of a series of spherical beads (18) threaded upon a flexible fishing line (16). The beads are threaded loosely on the fishing line to provide a prescribed spacing (30) and a flexible joint (26) about which worm body (C) flexes in all directions to simulate the natural motion of a worm upon retrieval of the artificial lure. A weight (D) threaded onto the fishing line and about the middle of worm body (C) provides an unusual undulating motion to worm body sections (22 and 24) defined on either side of weight (D). The amount of weight (D) may be prescribed in order to change artificial fishing worm (A) from a top water lure to a lure which may be fished at desired depths below the surface of the water.

**The Massie Patent**

The Massie patent discloses a fishing lure that includes a contoured longitudinal strip of metal, e.g. copper, that flutters when moving through water. The fluttering strip collides with an associated non-fluttering strip of a dissimilar metal, e.g. zinc, suspended from the same fixture as the copper strip. Similar to the Richard patent, the fishing lure's operating principle is that



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the dissimilar metallic strips form a galvanic cell, i.e. a galvanic couple in the terminology of the Richard patent. The lure's immersion in and movement through water cause the dissimilar metallic electrodes to flutter between a separated position and momentary contact. Mechanical contact between the electrodes produces pulses both of:

1. electricity; and
2. sound.

The rate at which pulses occur varies depending upon the shape, size, and weight of the electrodes, and upon the velocity at which the lure moves through the water. (Col. 1, line 31 - col. 2, line 10) The Massie patent discloses that it has been long known that electrical pulses and sonic waves attract fish. (Abstract)

#### **The Rodgers Patent**

The Rodgers patent discloses a fishing lure that includes an encapsulated battery, a motion responsive switch, a timing circuit, and output circuit which includes a light emitting diode ("LED"). Preferably, the lure also includes a piezotronic speaker encapsulated into the lure's plastic body. The surface of the lure includes exposed, water sensing probes 11 and 13 that connect to the timing circuit. Field effect probes 29 and 31, connected to the output circuit, are also exposed on the body's surface at

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opposite ends of the lure, on opposite sides of the lure, or at any other selected location. (Col. 2, lines 32-48)

To prevents wasting battery energy when the lure is out of the water, a lack of electrical conduction between the water sensing probes disables the timing circuit. (Col. 3, lines 19-38) When electrical conduction occurs between the water sensing probes and the lure moves through water, the timing circuit responds to off-to-on transitions of the motion responsive switch. An off-to-on transition of the motion responsive switch activates operation of the timing circuit for generating a power interval during which electrical power, i.e. a pulse, is supplied from the battery to the output circuit. The timing circuit will not start timing a new pulse power interval during a power interval, but only responds to off-to-on transitions of the motion responsive switch which occur outside the pulse power interval. During the pulse power interval, the output circuit supplies electricity to the LED, the speaker and/or the field effect probes. (Col. 1, lines 48-61) The field effect probes, by virtue of the electric field between them, create a pulsed electric field in the water that attracts fish and simulates the electrical charge generated by nerve endings in the muscles of all fish and animals when in motion. (Col. 2, lines 48-52)

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### Electrets

The American Heritage Dictionary defines an electret as:

a solid dielectric that exhibits persistent dielectric polarization. (Emphasis supplied.)

The Columbia Encyclopedia, Sixth Edition. Copyright - 2002 Columbia University Press, discloses that an electret is a:

solid electrically insulating, or dielectric, material that has acquired a long-lasting electrostatic polarization. Electrets are produced by heating certain dielectric materials to a high temperature and then letting them cool while immersed in a strong electric field. (Emphasis supplied.)

The text of each and every independent claim pending in this application, i.e. claims 1, 17, 22, 24, 27, 37, 40 and 43, expressly encompasses a combination which includes an electret. None of the references cited in rejecting pending claims 1-47 discloses, or even suggests, an electret, i.e.

a solid dielectric that exhibits persistent dielectric polarization.

### Claim Rejections

#### Based upon the Richard Patent

The July 1, 2003, Office Action<sup>3</sup> in paragraph no. 4 on page 3 rejects claims 1-3, 12-15, 24, 26 and 40-41 based upon the Richard patent alleging generally:

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<sup>3</sup> Expressly incorporated by reference in the March 8, 2004, Office Action.

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[t]he bioelectric simulating means [disclosed in the Richard patent] is formed by the anode and cathode formed adjacent the point of the hook. In reference to claim 1, it would have been obvious to provide Richard with the electret disposed on the shank adjacent the hook eye since a breakage at this point would also cause the hook to fail. (Emphasis supplied.)

Claims 1-3, 12-15, 24, 26 and 40-41 rejected based upon the Richard patent include independent claims 1, 24 and 40. In addition to the preceding general application of the Richard patent to claims 1-3, 12-15, 24, 26 and 40-41, the July 1, 2003, Office Action expressly applies the Richard patent to only independent claim 40.

In reference to claim 40, Richard shows all of the elements recited with the exception of the extension hardware coupled to the eye. However, it would have been obvious to employ old and well extension hardware to space the hook from the fish line. (Emphasis supplied.)

Paragraph no. 4 of the July 1, 2003, Office Action fails to expressly apply the Richard patent to independent claims 1 or 24.

**Based upon the Combined  
Richard and Barfield Patents**

The July 1, 2003, Office Action<sup>4</sup> in paragraph no. 5 on page 4 rejects claims 4-11, 16, 25 and 42-47 based upon the combined Richard and Barfield patents alleging generally:

[t]he patent to Richard shows a fishhook as discussed above. The patent to Barfield shows a fishing lure

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<sup>4</sup> Expressly incorporated by reference in the March 8, 2004, Office Action.

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having an artificial lure A' located on the fishhook as shown in Fig. 7. In reference to claims 4-5, it would have been obvious to provide the hook of Richard with an artificial lure mounted on the fishhook for the purpose of attracting more fish to the lure and inducing those to strike the lure which increases the number of fish caught.

Claims 4-11, 16, 25 and 42-47 rejected based upon the combined Richard and Barfield patents include independent claim 43. Paragraph no. 5 of the July 1, 2003, Office Action fails to expressly apply the combined Richard and Barfield patents to independent claim 43.

#### Based upon the Massie Patent

The July 1, 2003, Office Action<sup>5</sup> in first paragraph no. 6 on page 4 rejects claims 22-24 and 37-39 based upon the Massie patent alleging:

[t]he patent to Massie shows a fishing lure having a plurality of strands 6, 7, one of the strands is considered as the anodic segment and the other of the strands is considered as the cathodic segment. Massie has the strands separated and an electronic current flows between the fluttering electrodes which inherently produces an electromagnetic field and a bioelectric simulating means. In reference to claim 22, it would have been obvious to provide Massie with anodic and cathodic segments on the same strand although Massie shows separate strands the anodic and cathodic since the function is the same and no stated problem is solved. (Emphasis supplied.)

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<sup>5</sup> Expressly incorporated by reference in the March 8, 2004, Office Action.

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Claims 22-24 and 37-39 rejected based upon the Massie patent include independent claims 22, 24 and 37. In addition to the preceding general application of the Massie patent to claims 22-24 and 37-39, as excerpted above the July 1, 2003, Office Action expressly applies the Massie patent to only independent claim 22. First paragraph no. 6 of the July 1, 2003, Office Action in rejecting claims based upon the Massie patent fails to:

1. expressly apply the reference to independent claims 24 or 37; or
2. to even mention an electret.

#### Based upon the Rodgers Patent

The July 1, 2003, Office Action<sup>6</sup> in second paragraph no. 6 on page 5 rejects claims 17-22 and 27-36 based upon the Rodgers patent alleging:

[t]he patent to Rodgers shows a bioelectric simulating fishing lure having a body and electrically conductive strands 11, 13 which have sections secured to the body and other sections that protrude from the body as shown in Fig. 1. The strands are treated to provide the biosimulating means which upon immersion in water an electromagnetic field is produced about the lure to induce a strike from a fish as disclosed in column 2, lines 46-52. In reference to claims 17 and 22, it would have been obvious to provide Rodgers with an electret on one of the strands rather than use two strands to make up the electret since the function is the same. Rodgers does not disclose replacing the fishhook to change

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<sup>6</sup> Expressly incorporated by reference in the March 8, 2004, Office Action.

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cathodic segments, but it would have been obvious to change the fishhook to change cathodic segments instead of replacing segments 11, 13 since the function is the same and no stated problem is solved. (Emphasis supplied

FIGs. 1 and 2 of the Rodgers patent, a copy of which is attached hereto as Exhibit A, clearly depict water sensing probes 11 and 13, that connect to the timing circuit, as extending to only the surface of the lure as expressly described in column 2 at lines 42-44 of that reference's text. Thus, the reference's text expressly contradicts the preceding allegation excerpted from the July 1, 2003, Office Action that the Rodgers patent discloses "sections that protrude from the body." Because the strands 11, 13 do not "protrude from the body," it is impossible "to provide Rodgers with an electret on one of the strands rather than use two strands to make up the electret" as alleged in the July 1, 2003 Office Action.

Claims 17-22 and 27-36 rejected based upon the Rodgers patent include independent claims 17, 22 and 27. In addition to the preceding general application of the Rodgers patent to claims 22-24 and 37-39, as excerpted above the July 1, 2003, Office Action expressly applies the Rodgers patent to only independent claims 17 and 22. Second paragraph no. 6 of the July 1, 2003, Office Action in rejecting claims based upon the Rodgers patent, in addition to mischaracterizing the reference's disclosure, fails to expressly apply the reference to independent claim 27.

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**Legal Principles Applicable to  
Rejections Under 35 U.S.C. 103(a)**

Certain well established principles must be applied in assessing if an invention is patentable under 35 U.S.C. 103(a). First, the claims of a patent, which define the invention, are "to be construed in light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966). The "differences between the prior art and the claims at issue are to be ascertained." Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Moreover, it is elementary that the claimed invention must be considered as a whole in deciding obviousness. Litton Industrial Products, Inc. v. Solid State Systems Corp., 755 F.2d 158, 164, 225 USPQ 34, 38 (Fed. Cir. 1985). The prior art as a whole must be considered, and those portions of the prior art arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 448, 230 USPQ 416, 420 (Fed. Cir. 1986), In re Hedges, et al., 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986).

**An invention is obvious under 35 U.S.C. § 103(a), only if the prior art suggests a modification of the reference(s) and/or their combination.** In In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) the Court of Appeals for the Federal Circuit



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("CAFC") reversed a Board of Appeals decision that a patent application's claims were obvious under 35 U.S.C. § 103 holding "that although a prior art [fuel filter] device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down." Continental Can Co. USA, Inc. v. Monsanto Co. 948 F.2d 1264, \_\_\_, 20 USPQ2d 1746, 1751 (Fed. Cir. 1991). "The mere fact that the prior art could be . . . modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, supra at 221, 1127. (Emphasis supplied) In accord, In re Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

For a single reference to render a claimed invention obvious under 35 U.S.C. § 103(a), the Court of Appeals for the Federal Circuit in In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) held that although a prior art device "may be capable of being modified to run the way [the inventive] apparatus is claimed, there must be a suggestion or motivation in the reference to do so." In re Naylor, 369 F.2d 765, 768, 152 USPQ 106, 108 (CCPA 1967) quoting In re Spormann, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). An examiner is obliged to explain why one skilled in the art would make a substitution. Ex parte Skinner, 2 USPQ2d 1788, 1790 (Bd. Pat. App. & Int. 1986).

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Modifying a reference to such an extent that it no longer works for its intended purpose is an unobvious modification. The reference as so modified can no longer be applied to render a claimed invention obvious. "Indeed, if the French [fuel filter] apparatus were turned upside down, it would be rendered inoperable for its intended purpose." In re Gordon, supra citing Application of Schulpen 390 F.2d 1009, 1013, 157 USPQ 52, 55 (CCPA 1968). In Application of Schulpen the Court of Custom and Patent Appeals ("CCPA") reversed a Board of Appeals decision that a patent application's claims were obvious under 35 U.S.C. § 103 because an allegedly obvious modification of the reference would render the apparatus inoperable for producing the apparatus' intended product. A rejection of claims under 35 U.S.C. § 103 based upon inserting negative lenses, disclosed in one reference, into a camera accessory housing between a lens and a film plane, disclosed in a basic reference, was improper because it destroyed the basic reference for its intended purpose. Ex parte Westphalen, 159 USPQ 507, 508 (Bd. App. 1967). Similarly, claims to a deeply-drawable composite formed by coating a partially drawn non-woven fleece, allegedly disclosed in one reference, with a deep-drawable plastic film, disclosed in a second reference, were improperly rejected as being obvious because the combination destroyed the invention disclosed in the first reference. Ex parte Hartman, 186 USPQ 366, 367 (Bd. App. 1974).

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The Manual of Patent Examining Procedure ("MPEP") § 2143.01, Eighth Edition, August 2001, at p. 2100-124 - 125, in applying the controlling legal authority cited above expressly instructs examiners that claims are not to be rejected for obviousness under 35 U.S.C. § 103(a) relying upon a combination of references that renders one of the references inoperable for that reference's intended purpose. This text in MPEP expressly states as follows.

THE PROPOSED MODIFICATION CANNOT  
RENDER THE PRIOR ART UNSATISFACTORY  
FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In *re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

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Correspondingly, MPEP § 2143.01 further declares that:

THE PROPOSED MODIFICATION CANNOT  
CHANGE THE PRINCIPLE OF OPERATION  
OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In *re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Applying the preceding principles to the pending claims and to the various references discussed herein, Appellant respectfully submits that for the reasons set forth in detail below a proper application of the references to pending claims 1-47 in accordance with controlling legal precedents fails to render those claims obvious.

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**All Claim Rejections  
Are Legally Insufficient**

The July 1, 2003, Office Action's rejections of claims all require modification of the cited reference(s). Ex parte Skinner supra mandates that an examiner explain why one skilled in the art would make a substitution. Since the references applied in rejecting pending claims 1-47 fail to disclose or even suggest an electret, rejecting the pending claims based upon those references necessarily requires modifying each of them. At best, the rejection of claims appearing in the July 1, 2003, Office Action include only a conclusory "it would have been obvious" recitation in support of claim rejections. None of the rejections attempt to explain why one skilled in the art would substitute an electret. Therefore, because all claim rejections appearing in the July 1, 2003, Office Action violate the mandate of Ex parte Skinner supra, those rejections are legally insufficient, and for that reason claims 1-47 necessarily must be declared patentable.

**All Claim Rejections  
Fail to State a Motivation**

None of the references disclose or do they even suggest use of an electret. Both the Richard and Massie patents rely upon a galvanic cell, i.e. a galvanic couple, for their operation. The Massie and Rodgers patents respectively disclose pulsed electric fields for attracting fish produced either mechanically (the Massie

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patent) or electronically (the Rodgers patent). When holding claims obvious based upon a single reference, In re Mills supra mandates that there must exist a suggestion or motivation in the reference to modify the prior art device to run the way the inventive apparatus is claimed. The rejections appearing in the July 1, 2003, Office Action fail to identify in any of the references any suggestion or motivation for their modification, no less a suggestion or motivation to utilize an electret. Therefore, because all claim rejections appearing in the July 1, 2003, Office Action violate the mandate of In re Mills supra, those rejections are legally insufficient, and for that reason claims 1-47 necessarily must be declared patentable.

**Unobvious Modifications of the  
References Render Them Unsatisfactory  
for Their Intended Purposes**

MPEP § 2143.01 citing In re Gordon supra declares that:

[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

**The Richard and Barfield Patents**

The Richard patent discloses a fish hook that when immersed in water creates a galvanic couple between the fish hook's dissimilar metals. Action of the galvanic couple causes a small anodic area

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of the fish hook's exposed steel to corrode rapidly thus causing the fish to eventually break.

If as alleged in the July 1, 2003, Office Action an electret were substituted for the dissimilar metals of the Richard patent's fish hook, that would eliminate the galvanic couple thereby preventing corrosion and breakage of the fish hook. Because substituting an electret for the Richard patent's dissimilar metals renders its fish hook unsatisfactory for its intended breakage purpose, under MPEP § 2143.01 and In re Gordon supra there can exist no suggestion or motivation to make the modifications proposed in the July 1, 2003, Office Action. Consequently, there can exist no suggestion or motivation to modify the fish hook disclosed in the Richard patent as required by the rejections of claims 1-16, 24-26 and 40-47 appearing in the July 1, 2003, Office Action based upon either:

1. the Richard patent alone, claims 1-3, 12-15, 24, 26 and 40-41; or
2. the Richard patent in view of the Barfield patent, claims 4-11, 16, 25 and 42-47.

Therefore, because under the controlling authority of MPEP § 2143.01 and In re Gordon supra there exists no motivation for the modifications of the Richard patent or of the Richard patent in view of the Barfield patent that appear in the July 1, 2003, Office Action's rejections of pending claims 1-16, 24-26 and 40-47, those

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modifications are unobvious, and for that reason claims 1-16, 24-26 and 40-47 must be declared patentable.

### **The Massie and Rodgers Patents**

The Massie and Rodgers patents respectively disclose pulsed electric fields for attracting fish produced either mechanically (the Massie patent) or electronically (the Rodgers patent). Because an electret exhibits persistent dielectric polarization, substituting an electret for the Massie patent's contoured longitudinal strip of metal that flutters when moving through water does not produce a pulsed electrical field when the electret contacts another portion of the fishing lure. Similarly, because an electret exhibits persistent dielectric polarization, substituting an electret for the Rodgers patent's encapsulated battery, a motion responsive switch, a timing circuit, output circuit and field effect probes 29 and 31 does not produce a pulsed electrical field.

Because the respective modifications of the Massie and Rodgers patents required by the July 1, 2003, Office Action render them unsatisfactory for their intended purpose of producing pulsed electrical fields, under MPEP § 2143.01 and In re Gordon supra there can exist no suggestion or motivation to modify the fishing lures disclosed respectively in those references. Therefore, because under the controlling authority of MPEP § 2143.01 and In re



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Gordon supra there exists no motivation for the modifications of the Massie or of the Rodgers patents that appear in the July 1, 2003, Office Action's rejections of claims 17-24, and 27-39, those modifications are unobvious, and for that reason claims 17-24, and 27-39 must be declared patentable.

**Modifications of the References  
Change Their Principle of Operation**

MPEP § 2143.01 citing In re Ratti, 270 F. 2d 810, 123 USPQ 349 (CCPA 1959) declares that:

[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.

**The Richard, Richard and  
Barfield, and Massie Patents**

Operation of the inventions disclosed in the Richard and Massie patents respectively require a galvanic cell, i.e. a galvanic couple. If as alleged in the July 1, 2003, Office Action an electret were substituted for the dissimilar metals of the Richard patent's fish hook, or of the Massie patent's contoured longitudinal strip of metal that flutters when moving through water, that would change those references principle of operation by eliminating their respective galvanic cells, i.e. galvanic couples. Because the July 1, 2003, Office Action's rejections of claims

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1-16, 22-26 and 37-47 based upon the Richards, Barfield and Massie patents change those references' principle of operation, then under MPEP § 2143.01 and In re Ratti supra the teachings of those references are insufficient to render the claims prima facie obvious. Thus, since the rejections of pending claims 1-16, 22-26 and 37-47 based upon the Richards, Barfield and Massie patents do not render those claims prima facie obvious, those claims must necessarily be declared patentable.

#### **The Massie Patent**

The Massie patent discloses an active electronic circuit, i.e. an encapsulated battery, a motion responsive switch, a timing circuit, output circuit and field effect probes 29 and 31, for producing an electrical field. Replacing the encapsulated battery, a motion responsive switch, a timing circuit, output circuit and field effect probes 29 and 31 with an electret changes the Massie patent's principle of operation from that of an active electronic circuit, i.e. an electronic circuit through which electrical current flows and circuit elements turn on and off, to that of a passive, static device that cannot provide a flowing electrical current. Because the rejections of claims 17-22 and 27-36 based upon the Rodgers patent change that reference's principle of operation, then under MPEP § 2143.01 and In re Ratti supra the teachings of that reference are insufficient to render the claims

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prima facie obvious. Thus, since the rejections of pending based upon the Rodgers patent does not render claims 17-22 and 27-36 prima facie obvious, those claims must necessarily be declared patentable.

### Conclusion

As explained in greater detail above, under controlling legal authority claims 1-47 must all be declared patentable because the rejections that appear in the July 1, 2003, Office action fail:

1. to explain why one skilled in the art would substitute an electret for either:
  - a. a galvanic cell, i.e. a galvanic couple, or
  - b. an active electronic circuit, Ex parte Skinner supra; and
2. to identify any suggestion or motivation in the references to modify their respective inventions to operate in of the way the inventive apparatus encompassed by claims 1-47, In re Mills supra.

Similarly, as demonstrated above, because the modifications of the Richard, Richard and Barfield, Massie and Rogers patents that appear in the July 1, 2003, Office Action render them all respectively unsatisfactory for their intended purposes, then under MPEP § 2143.01 and In re Gordon supra claims 1-47 must be declared patentable.

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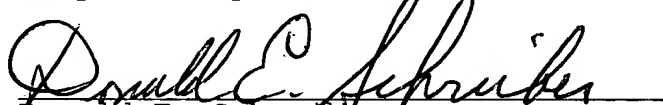
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Finally, as demonstrated above, because the modifications of the Richard, Richard and Barfield, Massie and Rogers patents that appear in the July 1, 2003, Office Action change each reference's principle of operation, then under MPEP § 2143.01 and In re Ratti supra claims 1-47 must be declared patentable.

For each and every one of the four (4) reasons set forth above, Appellant respectfully requests that the final rejection of claims made by the March 8, 2004, Office Action, that incorporates by reference the rejections appearing in the July 1, 2003, Office Action, be reversed, and claims 1-47 now pending in this patent application be declared patentable.

Respectfully submitted

  
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**APPENDIX I**  
**CLAIMS**

1. A bioelectric simulating fishhook comprising:  
a shank having an eye formed at an end thereof, the eye  
adapting the fishhook for coupling to a fishing line;

a bend formed at an end of the shank distal from the eye;

5 a point formed at an end of the bend distal from the shank;  
and

a self-contained bioelectric simulating means which, to  
induce a strike response in fish, includes an electret and is  
disposed on the shank.

2. The fishhook of claim 1 wherein said bioelectric  
simulating means further includes:

an anodic segment, formed by an anodic material, that is  
located along the fishhook where said anodic segment becomes  
5 exposed to water upon immersion of the fishhook therein; and

a cathodic segment, formed by a cathodic material, that is  
also located along the fishhook where said cathodic segment  
becomes exposed to water upon immersion of the fishhook therein,  
and that is separated from the anodic segment.

3. The fishhook of claim 2 further comprising an insulat-  
ing segment, formed by an electrically insulating material, that  
is located along the fishhook between said anodic segment and

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5 said cathodic segment where said insulating segment becomes exposed to water upon immersion of the fishhook therein for insulating the fishhook thereabout from electrical contact with the water.

4. The fishhook of claim 3 further comprising an artificial lure disposed upon the fishhook.

5. The fishhook of claim 4 wherein said artificial lure is made from an electrically insulating material, and both said anodic segment and said cathodic segment are not covered by said artificial lure.

6. The fishhook of claim 4 wherein said artificial lure is made from an electrically insulating material and provides said insulating segment of the fishhook.

7. The fishhook of claim 3 wherein a quantity of anodic material included in the fishhook is less than a quantity of cathodic material included therein.

8. The fishhook of claim 3 wherein said anodic segment overcoats a comparatively heavy, electrically conductive material thereby adding weight to fishhook.

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9. The fishhook of claim 3 wherein said anodic segment and cathodic segment are arranged along the fishhook so that during retrieval of the fishhook said anodic segment precedes said cathodic segment through water surrounding the fishhook.

10. The fishhook of claim 2 further comprising an artificial lure disposed upon the fishhook.

11. The fishhook of claim 1 further comprising an artificial lure disposed upon the fishhook.

12. The fishhook of claim 1 wherein said shank adjacent to the eye has an enlarged portion that is larger than said bend and other portions of said shank.

13. The fishhook of claim 12 wherein material forming the enlarged portion is heavier than material of said shank.

14. The fishhook of claim 1 having at least a pair of bends each of which has a point formed at an end of such bend distal from the shank connected thereto.

15. The fishhook of claim 14 wherein said bioelectric simulating means further includes:

an anodic segment, formed by an anodic material, that is located along a first bend of the bends where said anodic segment becomes exposed to water upon immersion of the fishhook therein; and

a cathodic segment, formed by a cathodic material, that is also located along a second bend of the bends where said cathodic segment becomes exposed to water upon immersion of the fishhook therein.

16. The fishhook of claim 15 further comprising an insulating segment, formed by an electrically insulating material, that is located about the shank between said anodic segment of the first bend and said cathodic segment of the second bend where said insulating segment becomes exposed to water upon immersion of the fishhook therein for insulating the fishhook thereabout from electrical contact with the water.

17. A bioelectric simulating artificial lure comprising:  
a body; and

at least one fine strand, said strand having a section secured in said body and at least another section that protrudes out from said body, at least a section of said strand which protrudes from said body having at least a portion of a self-contained bioelectric simulating means which includes an electret



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and is disposed on said strand to induce a strike response in fish.

18. The artificial lure of claim 17 wherein a treated section of said strand further includes an anodic segment when said strand becomes exposed to water upon immersion of the artificial lure therein.

19. The artificial lure of claim 18 wherein a treated section of said strand also further includes a cathodic segment when said strand becomes exposed to water upon immersion of the artificial lure therein.

20. The artificial lure of claim 19 wherein the cathodic segment of said electrically conductive strand is coupled electrically to said anodic segment of said electrically conductive strand.

21. The artificial lure of claim 17 wherein said body is formed from an electrically insulating material.

22. A bioelectric simulating skirt adapted to be secured to an artificial lure comprising:

a plurality of fine strands each having at least a portion of a self-contained bioelectric simulating means which includes  
5 an electret disposed on at least one of said strands to induce a strike response in fish.

23. The skirt of claim 22 wherein said strands further comprise an insulating segment, formed by an electrically insulating material, that is located along at least one of said strands between an anodic segment and a cathodic segment of the  
5 bioelectric simulating means where said insulating segment becomes exposed to water upon immersion of the skirt therein for insulating said strand thereabout from electrical contact with the water.

24. A bioelectric simulating bait spear adapted for attachment to an artificial lure comprising:

at least one strand adapted for insertion into an artificial lure, said strand having at least a portion of a self-contained  
5 bioelectric simulating means which includes an electret disposed on said strand to induce a strike response in fish.

25. The bait spear of claim 24 wherein said strand further comprise an insulating segment, formed by an electrically insulating material, that is located along said strand between an

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anodic segment and a cathodic segment where said insulating  
5 segment becomes exposed to water upon immersion of the bait spear  
therein for insulating said strand thereabout from electrical  
contact with the water.

26. The bait spear of claim 24 wherein said strand is  
U-shaped thereby adapting said strand for piercing through the  
artificial lure.

27. A bioelectric simulating artificial lure comprising:  
a solid body having at least a portion of a self-contained  
bioelectric simulating means which includes an electret disposed  
on said body to induce a strike response in fish.

28. The artificial lure of claim 27 wherein said body is  
formed from an electrically insulating material.

29. The artificial lure of claim 28 wherein said body  
further includes electrically conductive material that intercon-  
nects an anodic segment with a cathodic segment.

30. The artificial lure of claim 27 wherein an anodic  
material is embedded within a porous material that forms at least  
a portion of said body.

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31. The artificial lure of claim 27 wherein a cathodic material is embedded within a porous material that forms at least a portion of said body.

32. The artificial lure of claim 27 further comprising a conductivity-enhancing material which becomes exposed to water upon immersion of the artificial lure therein for increasing electrical conductivity of water about the artificial lure.

33. The artificial lure of claim 27 wherein an anodic segment of the artificial lure is replaceable.

34. The artificial lure of claim 33 wherein a replaceable fishhook provides the anodic segment of the artificial lure.

35. The artificial lure of claim 27 wherein a cathodic segment of the artificial lure is replaceable.

36. The artificial lure of claim 35 wherein a replaceable fishhook provides the cathodic segment of the artificial lure.

37. A bioelectric simulating sticker adapted to be fastened to an artificial lure comprising:

a sheet of material that includes securing means for fasten-  
ing said sheet to the artificial lure, said sheet having a self-  
5 contained bioelectric simulating means which includes an electret  
disposed thereon to induce a strike response in fish.

38. The artificial lure of claim 37 wherein the securing  
means is a layer of adhesive material coated onto a surface of  
said sheet.

39. The artificial lure of claim 37 wherein a portion of  
said sheet between an anodic segment thereof and a cathodic  
segment thereof includes an electrically insulating material.

40. A bioelectric simulating fishhook comprising:

a bend;

a point formed at a first end of the bend;

a shank extending from a second end of the bend distal from  
5 said point, said shank also having an eye formed at an end  
thereof that is distal from the bend;

extension hardware coupled to the eye that adapts the  
fishhook for coupling to a fishing line; and

self-contained bioelectric simulating means on the fishhook,  
10 said bioelectric simulating means including an electret to induce  
a strike response in fish.

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41. The fishhook of claim 40 wherein said bioelectric simulating means further includes:

an anodic segment, formed by an anodic material, that is located on the extension hardware where said anodic segment becomes exposed to water upon immersion of the fishhook therein; and

a cathodic segment, formed by a cathodic material, that is located along the fishhook separated from said extension hardware where said cathodic segment becomes exposed to water upon immersion of the fishhook therein.

42. The fishhook of claim 41 further comprising an insulating segment, formed by an electrically insulating material, that is located along the fishhook between said anodic segment and said cathodic segment where said insulating segment becomes exposed to water upon immersion of the fishhook therein for insulating the fishhook thereabout from electrical contact with the water.

43. A bioelectric simulating trailer rod adapted to be secured to a bend of a fishhook, the trailer rod comprising:

a shank adapted for having an eye formed at one end thereof for securing the trailer rod to the bend of the fishhook; and

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5 self-contained bioelectric simulating means located on the trailer rod, said bioelectric simulating means including an electret to induce a strike response in fish.

44. The trailer rod of claim 43 wherein said bioelectric simulating means further includes:

an anodic segment, formed by an anodic material, that is located on the trailer rod where said anodic segment becomes  
5 exposed to water upon immersion of the trailer rod therein; and

a cathodic segment, formed by a cathodic material, that is located on the trailer rod separated from the anodic segment where said cathodic segment becomes exposed to water upon immersion of the trailer rod therein.

45. The trailer rod of claim 44 wherein said shank is electrically conducting.

46. The trailer rod of claim 45 further comprising an insulating segment, formed by an electrically insulating material, that is located along the trailer rod between said anodic segment and said cathodic segment where said insulating segment  
5 becomes exposed to water upon immersion of the trailer rod therein for insulating the trailer rod thereabout from electrical contact with the water.

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47. The trailer rod of claim 44 wherein said shank has an eye formed thereon which provides an opening sufficiently large so the point and barb of a fishhook will pass therethrough.



